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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/851,040	05/05/97	VISSER B	17342-000500

PM82/0820

TOWNSEND AND TOWNSEND AND CREW
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO CA 94111-3834

EXAMINER	
KANG, T	
ART UNIT	**PAPER NUMBER**
3635	16

DATE MAILED: 08/20/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/851,040	Applicant(s) Visser
	Examiner Timothy Kang	Group Art Unit 3635

☒ Responsive to communication(s) filed on *Jun 7, 1999*.

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *three* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-4, 6-16, and 18-36* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-4, 6-16, and 18-36* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

The following Office Action is responsive to the request for reconsideration filed on June 7, 1999, on application serial number 08/851,040, filed by Barney D. Visser.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-4, 6-16, and 18-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Searcy 4,154,027.

Searcy discloses the elements of applicant's claimed invention, including, at least three separate stores (66, 64, 116), each having elongate walls (80, 70, 68, 120, 124, 22, 24), doorways being aligned with each other (84, 88, 128), and an aisle (comprising the space located between the stores (64, 66, 116)). It would have been obvious to one having ordinary skill in the art to make each store (room) be managed independently since this is the common practice in most department stores. Regarding the limitation that each store have at least one separate outside entrance which lead directly to a parking facility, the examiner takes judicial notice that this is common practice in most shopping plazas and would therefore have been obvious to one having ordinary skill in the art.

Additionally, the examiner takes Judicial Notice that in most department stores such as Macy's, Nordstrom, Bloomingdale's, etc., there are separate sections/departments (with

orthogonal walls and distinct entrances which directly to a parking facility) reserved for special merchandises such as designer's, furs, evening wears, etc. that could be considered as "separate stores" which are managed independently from one another. Customers would be able to walk through those sections/departments and view the merchandise in other sections/departments when looking down the aisle/walk-through spaces.

Furthermore, the examiner takes Judicial Notice that in many malls such as Potomac Mills, Tysons Corner, Pentagon City Mall, all located in Northern Virginia, there are separate stores (with orthogonal walls and multiple distinct outside entrances) each specializing in one type of merchandise, such as, furniture, clothing, toys, etc. that is managed by their own salestaff. Since most mall lay-outs include distinct wings, many stores would have both inside and outside entrances and the doors are usually aligned because most stores run along a straight elongated corridor. Customers would be able to walk through those stores and view the merchandise in other stores when looking down the aisle/walk-through spaces because stores typically have glass fronts and merchandise are displayed very close to the entrance. Therefore, applicant's claimed invention could further be rejected on the basis that the limitations of the claimed invention are functionally equivalent to existing layouts for the reasons as stated above.

The limitations of applicant's claim 16 directed to the merchandise are considered as being functions of design choice. Claims 25-36 are considered as being merely the inherent method of presenting inventory items in department stores or stores in malls.

Response to Arguments

3. Applicant's arguments filed on June 7, 1999 have been fully considered but they are not persuasive. Please refer to the rejections as cited hereinabove.

In response to applicant's argument that the examiner's taking of Judicial Notice is based upon improper hindsight construction, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, the positioning in stores of doorways that lead directly to parking facilities is notoriously old and well known and would therefore be clearly within the level of ordinary skill in the art. One reason for positioning a doorway that leads directly to a parking facility is that, in most stores, deliveries are made through a rear entrance thereof so that business conducted in the front of the stores is not disrupted. Additionally, trash is usually removed through a rear entrance since most trash receptacles are positioned behind the stores.

In response to applicant's argument that room 66 of Searcy would not require a customer entrance from a parking facility, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re*

Casey, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, the modification of the Searcy reference to include a doorway that leads to a parking facility, although for different reasons than that of the applicant, would, nonetheless, have been obvious to one having ordinary skill in the art. By calling such a doorway a "customer entrance", applicant is merely claiming that the intended use of the doorway is for customers. However, since structurally, a doorway is a doorway, the modification of Searcy to include a doorway that leads directly to a parking lot for the purposes of receiving deliveries and for trash removal, renders applicant's claimed invention unpatentable.

Regarding applicant's claims 11, 25, and 31, it is apparent that applicant misunderstood the conversation summarized in the Interview Summary Report. Examiner stated that it would not have been obvious to use dividers having a pair of openings therein with a circuiting aisle running through both of said openings. The instant claims do not show this limitation and therefore, claims 11, 25, and 31 are still deemed unpatentable for the reasons as stated hereinabove.

Applicant's arguments directed to the Judicial Notice that "separate stores" does not include separate sections/departments within a department store are not persuasive. "Store" as defined in the Webster's II New Riverside University Dictionary, 1994, states "A place where merchandise is offered for sale: SHOP", and "shop" is defined as "A small retail store or a specialty department in a large store". According the above dictionary, then, the sections/departments within a department store are themselves called "stores". Regarding applicant's argument that Nordstrom stores having doorways to separate sections/departments is

not well known in the art, the examiner maintains the position that such is well known in the art. Applicant is invited to visit the Nordstrom store located in Pentagon City Mall or to contact a representative thereof who can verify that two doorways do exist, at least on the second floor thereof, separating the men's department from a women's department, the area between the doorways including elevators and the help desk.

Applicant's arguments directed to the second Judicial Notice Rejection is not persuasive. The second Judicial Notice Rejection merely stated that applicant's claims could be rejected based on the functional equivalence between a mall having stores with glass windows facing the aisles within said mall and stores having aligned doorways. The basis of this possible rejection is that customers walking through the aisles could look through said windows to view the merchandise within each of the stores. This rejection did not state that the faxed floor plans showed three separate stores with aligned doorways, as purported by the applicant.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy Kang whose telephone number is (703) 308-1113. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Any other questions or concerns can be directed to the group receptionist who can be reached at (703) 308-1113.

Carl D. Friedman
Supervisory Patent Examiner
Group 3600

TBK
T.B.K.
August 17, 1999